THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte YUKI TSUSHIMA,
KAZUHIDE ASHIZAWA, and SUMIO WATANABE

_____

Appeal No. 97-2159
Application 08/127,555[1]

_____

ON BRIEF

_____

Before GARRIS, WALTZ, and SPIEGEL, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 3 through 5 and 10 through 17. Subsequent to the

[1] Application for patent filed September 28, 1993.

final rejection, the appellants submitted an amendment adding new independent claim 27 (see the amendment filed December 13, 1995 as Paper No. 14), and the examiner entered this amendment (see the advisory action mailed January 16, 1996 as Paper No. 15). Thus, claims 3 through 5, 10 through 17 and 27 are before us on this appeal (see the notice of appeal filed January 16, 1996 as Paper No. 16).

The subject matter on appeal relates to a method of preparing a molded, rapid disintegration human ingestible tablet in which a wetted paste of tablet material is placed in a mold cavity, compressed at a pressure of 5 to 100 Kg per 10 mm of tablet diameter, removed from the mold and dried to a rapid disintegration tablet. This appealed subject matter is adequately illustrated by independent claim 10 which reads as follows:

10. In a method of preparing a molded, rapid disintegration human ingestible tablet where a mold cavity is filled with a wetted paste of material forming the tablet to shape the wetted paste into a wetted tablet, the wetted tablet is removed from the mold cavity and dried to a rapid disintegration tablet, the improvement comprising compressing the wetted tablet while in the mold cavity at a pressure of 5 to 100 Kg per 10 mm of tablet diameter.

The reference relied upon by the examiner in the rejections before us is:

Schmitt 4,004,036 Jan. 18, 1977

As indicated by the examiner on pages 2 and 3 of the answer, claims 5 and 10 through 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Schmitt, and claims 3, 4, 16 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Schmitt.[2]

We will not sustain either of these rejections.

In order for a section 102 rejection to be proper, the applied reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the claimed invention without any need for picking, choosing and combining various disclosures not directly related to each other by the teachings of the reference. In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). In making her section 102 rejection of claims 5 and 10 through 15, it is apparent that the examiner has inappropriately picked, chosen and combined various disclosures of the Schmitt reference

[2] By an apparently inadvertent oversight, the examiner has failed to include independent claim 27 in the rejections advanced on this appeal. In order to completely disposed of the issues before us, we will assume that the above noted rejections include independent claim 27.

which are not directly related to each other.

An example of this inappropriate action by the examiner involves the limitation in the appealed independent claims concerning a wetted paste of material (claim 10) or a wetted powder (claim 27). Regarding this feature, Schmitt discloses that molded tablet triturates were "originally made from moist materials on a triturate mold and [are] now usually made on a tablet machine" (column 9, lines 53-55). Because patentee's triturate mold disclosure is not directly related to his tablet machine disclosure, the "moist materials" feature which is attributed by Schmitt to a triturate mold cannot also be attributed to a tablet machine as the examiner necessarily has done in her section 102 rejection.

In light of the foregoing, it is clear that the examiner's rejection under 35 U.S.C. § 102 cannot be sustained.

As for the section 103 rejection, it is here appropriate to clarify that the examiner's obviousness position is limited to the powder coating features of dependent claims 3, 4, 16 and 17. Thus, the section 103 rejection formulated by the examiner does not even address much less cure the deficiencies

discussed above with respect to her section 102 rejection. Because of these deficiencies, we also cannot sustain the examiner's rejection under 35 U.S.C. § 103.

For the above stated reasons, the decision of the examiner rejecting claims 3 through 5, 10 through 17 and 27 must be reversed.

REVERSED

Bradley R. Garris Administrative Patent Judge	)	
Thomas A. Waltz Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Carol A. Spiegel Administrative Patent Judge	)	

tdc

GRIFFIN, BUTLER, WHISENHUNT & KURTOSSY
Suite PH-1
2300 Ninth Street, South
Arlington, VA 22204